



OCT 11 2000

In re

DECISION ON
PETITION FOR REGRADE
UNDER 37 C.F.R. § 10.7(c)

MEMORANDUM AND ORDER

(petitioner) requests for regrading questions 16 and 39 of the morning section and questions 16 and 49 of the afternoon section of the Registration Examination held on April 12, 2000. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

BACKGROUND

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 69. On July 22, 2000, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, all regrade requests have been considered in the first instance by the Director of the USPTO.

OPINION

Under 37 C.F.R. § 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: "No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer which refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement *true*. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO," "PTO," or "Office" are used in this examination, they mean the U.S. Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers.

All of petitioners' arguments have been fully considered. Each question in the Examination is worth one point.

No credit has been awarded for morning questions 16 and 39 and afternoon questions 16 and 49. Petitioners' arguments for these questions are addressed individually below.

Morning question 16 reads as follows:

16. A patent specification discloses a personal computer comprising a microprocessor and a random access memory. There is no disclosure in the specification of the minimum amount of storage for the random access memory. In the disclosed preferred embodiment, the microprocessor has a clock speed of 100-200 megahertz. Claims 9 and 10, presented below, are original claims in the application. Claim 11, presented below, was added by amendment after an Office action.

- 9. A personal computer comprising a microprocessor and a random access memory including at least 1 gigabyte of storage.
- 10. The personal computer of Claim 9, wherein the microprocessor has a clock speed of 100-200 megahertz.
- 11. The personal computer of Claim 10, wherein the random access memory is greater than $\frac{1}{2}$ gigabyte of storage.

Which of the following statements is or are **true** about the respective claims under 35 U.S.C. § 112, fourth paragraph?

- (A) Claim 9 is a proper independent claim, and Claims 10 and 11 are proper dependent claims.
- (B) Claim 9 is a proper independent claim, and Claims 10 and 11 are improper dependent claims.
- (C) Claim 9 is an improper independent claim, and Claims 10 and 11 are improper dependent claims.
- (D) Claim 9 is an improper independent claim, and Claims 10 and 11 are proper dependent claims.
- (E) Claim 9 is a proper independent claim, Claim 10 is a proper dependent claim, and Claim 11 is an improper dependent claim.

The model answer is choice is (E). Claim 9 is a proper independent claim, Claim 10 is a proper dependent claim, and Claim 11 is an improper dependent claim.

Petitioner selected answer (C). Petitioner argues that choice C is correct since all of Claims 9-11 are improper under 35 U.S.C. 112, paragraphs 1 and 4 because the minimum storage limitation in the independent claim 9 is not supported by the specification.

Petitioners' arguments have been fully considered but they are not persuasive. Claim 9 is an original presented claim which is part of the disclosure as filed. According to MPEP

608.01(l), an original claim that includes subject matter not described should not be attacked either by objection or rejection. It is the description that is defective, not the claim. See MPEP 608.01(l). Therefore, claim 9 is a proper independent claim.

Under 35 U.S.C. § 112, paragraph 4, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. Since claim 9 is a proper independent claim and claim 10 further limits the claim subject matter by specifying the clock speed, therefore claim 10 is a proper dependent claim. Claim 11, however, is improper because it expands the subject matter in claim 9. The statement in answer (E) is correct.

Morning question 39 reads as follows:

39. Impermissible recapture in an application exists _____
- (A) if the limitation now being added in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application.
 - (B) if the limitation now being omitted or broadened in the present continuation was originally presented/argued/stated in a parent application to make the claims allowable over a rejection or objection made in the parent application.
 - (C) if the limitation now being omitted or broadened in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application.
 - (D) if the limitation now being omitted or broadened in the present reissue was being broadened for the first time more than two years after the issuance of the original patent.
 - (E) None of the above.

The model answer is choice is (C). Impermissible recapture in an application exists if the limitation now being omitted or broadened in the present reissue was originally

608.01(l), an original claim that includes subject matter not described should not be attacked either by objection or rejection. It is the description that is defective, not the claim. See MPEP 608.01(l). Therefore, claim 9 is a proper independent claim.

Under 35 U.S.C. § 112, paragraph 4, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. Since claim 9 is a proper independent claim and claim 10 further limits the claim subject matter by specifying the clock speed, therefore claim 10 is a proper dependent claim. Claim 11, however, is improper because it expands the subject matter in claim 9. The statement in answer (E) is correct.

Morning question 39 reads as follows:

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- (A) if the limitation now being added in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application.
 - (B) if the limitation now being omitted or broadened in the present continuation was originally presented/argued/stated in a parent application to make the claims allowable over a rejection or objection made in the parent application.
 - (C) if the limitation now being omitted or broadened in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application.
 - (D) if the limitation now being omitted or broadened in the present reissue was being broadened for the first time more than two years after the issuance of the original patent.
 - (E) None of the above.

The model answer is choice is (C). Impermissible recapture in an application exists if the limitation now being omitted or broadened in the present reissue was originally

presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application.

Petitioner selected answer (D). Petitioner argues that answer C is not correct because the statement in choice C may or may not be true depending on other facts that are not given. According to petitioner, C may not be true when the reissue claims were narrowed in certain respects and broader in certain respects. Petitioner also argues that answer D is correct because it is always true. To support the argument, petitioner cited cases to historically recapitulate the topics of reissue and recapture.

Petitioner's arguments have been fully considered but they are not persuasive. 35 U.S.C. § 251 states that "no reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent." This sets forth a two-year statutory bar on broadening reissues. The case law cited by petitioner to support her argument was decided before the enactment of this section of Title 35. As stated by the petitioner, the statute substituted the recapture rule announced by the Supreme Court in *Edward Miller & Co. v. Bridgeport Brass Company*, 104 U.S. 350 (1882), and codified the Supreme Court's decisions in *Sontag Chain Stores* and *U.S. Industrial Chemicals, Inc.* Therefore, equitable doctrine of the recapture rule should be interpreted based on the case law decided after the codification of the two-year bar on broadening reissues.

The current case law on the recapture rule is summarized in the MPEP 1412.02.

A reissue will not be granted to "recapture" claimed subject matter which was surrendered in an application to obtain the original patent. *Hester Industries, Inc. v. Stein, Inc.*, 142 F.2d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984); *In re Wadlinger*, 496 F.2d 1200, 181 USPQ

826 (CCPA 1974); *In re Richman*, 409 F.2d 269, 276, 161 USPQ 359, 363-364 (CCPA 1969); *In re Willingham*, 282 F.2d 353, 127 USPQ 211 (CCPA 1960).

Answer D is not correct because the broadened reissue presented more than two years after the issuance of the original patent is barred by 35 U.S.C. § 251, and not by the recapture rule. The recapture rule applies when the reissue claim is broadened based on subject matter surrendered in an application to obtain the original patent. Answer D did not states how the reissue claims are being broadened.

Answer C is correct regardless the reissue claims are narrowed in another aspect because recapture rule applies when the reissue claims are broadened based on subject matter which was surrendered in an application to obtain the original patent. According to the MPEP 1412.02, if the limitation now being omitted or broadened in the present reissue was originally presented/ argued/ stated in the original application to make the claims allowable over a rejection or objection made in the original application, the omitted limitation relates to subject matter previously surrendered by applicant, and impermissible recapture exists. Furthermore, if the reissue claim is broadened in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim. *Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165. Also see MPEP 1412.02.

Afternoon question 16 reads as follows:

Please answer questions 16 and 17 based on the following facts. On February 15, 1999, Debbie conceived a unique system for humanely caging hunting dogs and automatically feeding them at appropriate times. Debbie told her husband, Ted, about her idea that night, and the two spent the next four months working regularly on the concept. Ted built a cage that implemented the concept on June 17, 1999, and tested it on his own dogs for a week. It worked perfectly for its intended purpose. The next day, Ted visited a family friend, Ginny, who happened to be a registered practitioner, and asked her to prepare a patent application on Debbie's behalf. Ginny declined representation,

explaining that she was in the middle of trial preparation and would not be able to work on the application for at least four months. Ginny gave Ted the names of a number of qualified patent practitioners, suggesting he consider retaining one of them to promptly prepare the patent application, and explained that a delay in filing the patent application could prejudice Debbie's patent rights. Ted, however, felt uncomfortable going to a practitioner he did not know personally, and did not contact any of the individuals recommended by Ginny. After Ginny had completed her trial and was back in the office, Ted visited her on December 1, 1999. At that time Ginny agreed to represent Debbie. An application was filed in the PTO within 10 days.

On May 15, 1999, Billie conceived an idea substantively identical to Debbie's. Billie immediately prepared a detailed technical description including drawings and visited a registered practitioner. Billie filed a patent application on June 14, 1999. Later, on July 9, 1999, Billie built a cage that implemented the concept and had fully tested it by August 11, 1999.

16. Assuming Debbie's patent application is substantively identical to Billie's patent application, which of the following statements is most correct?

- (A) Nearly simultaneous invention by Debbie and Billie is proof that the invention is obvious and precludes patentability.
- (B) Nearly simultaneous invention by Debbie and Billie may be evidence of the level of skill in the art at the time of the invention.
- (C) Nearly simultaneous invention by Debbie and Billie may be evidence of a long-felt need for the invention.
- (D) Nearly simultaneous invention by Debbie and Billie may be evidence of commercial success of the invention.
- (E) Statements (A), (B), (C) and (D) are each incorrect.

The model answer is choice is (B). Nearly simultaneous invention by Debbie and Billie may be evidence of the level of skill in the art at the time of the invention.

Petitioner selected answer (E). Petitioner asserts that *In re Merck & Co.* cited by the PTO in support of the answer (B) does not address simultaneous inventions and the level of skill in the art. Petitioner argues that "[a]nswer (B) is neither true nor false, since evidence of near simultaneous invention 'may or may not be' indicative of obviousness (by establishing a higher level of skill in the art)." To support the argument, petitioner cited *Lindemann Maschinenfabrik*

GMBH v. American Hoist and Derrick Co., 221 USPQ 481, 487 (Fed. Cir. 1988) (“Because the state, 35 U.S.C. § 135, (establishing and governing interference practice) recognizes the possibility of near simultaneous invention by two or more equally talented inventors working independently, that occurrence may or may not be an indication of obviousness when considered in light of all the circumstance.”) Petitioner concludes that since nearly simultaneous invention is not always evidence of the level of skill in the art at the time of the invention, and therefore choice B is not the best answer.

Petitioner’s arguments have been fully considered but they are not persuasive. Contrary to petitioner’s assertion that *Lindemann* cited by the petitioner speaks of “obviousness” and not “level of skill” is immaterial, evidence of the level of skill in the art at the time of the invention is only one of the factual inquiries for determining obviousness. See MPEP 2141 and *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1996). According to *Lindemann*, when evidence considered in the light of all the circumstance, near simultaneous invention may or may not be an indication of obviousness. This is materially different than petitioner’s interpretation that near simultaneous invention may or may not be evidence of the level of skill in the art at the time of the invention.

Answer B is correct because *In re Merck & Co.*, 231 USPQ 375, 380 (Fed. Cir. 1986) noted that “[t]he additional, although unnecessary, evidence of contemporaneous invention is probative of ‘the level of knowledge in the art at the time the invention was made.’ *In re Farrenkopf*, 713 F.2d 714, 720, 219 USPQ 1, 6 (Fed. Cir. 1983).” The fact that near simultaneous invention may be evidence of the level of skill in the art at the time of the invention is also stated in *Monarch Knitting Machinery Corp. v. Sulzer Morat GmbH*, 45 USPQ2d 1977,

1983 (Fed. Cir. 1998), “[t]his court has noted the relevance of contemporaneous independent invention to the level of ordinary knowledge or skill in the art”, referring to *Merck*.

Furthermore, *The International Glass Company, Inc. v. United States*, 159 USPQ 434, 442 (US Cl.Ct, 1968), states that “[t]he fact of near [] simultaneous invention, though not determinative of statutory obviousness, is strong evidence of what constitutes the level of ordinary skill in the art.” Accordingly, nearly simultaneous invention by Debbie and Billie may be evidence of the level of skill in the art at the time of the invention. Therefore, choice E is not the best answer because choice B is the correct answer.

Afternoon question 49 reads as follows:

49. A parent application A was filed on September 9, 1988, and became abandoned on October 19, 1993. Application B was filed on October 21, 1993, and referred to application A as well as claimed the benefit of the filing date of application A. Application B issued as a patent on June 17, 1997. Application C was filed on October 29, 1993, and referred to application B as well as claimed the benefit of the filing date of application B. Application D was filed on December 20, 1996. Application D referred to application B and claimed the benefit of the filing date of application B. Both applications C and D were abandoned for failure to file a timely reply to Office actions that were mailed on April 20, 1999. Application E was filed on July 22, 1999 and is drawn to the same invention as claimed in applications C and D. Application E claims the benefit of the filing dates of applications A, B, C, and D, and makes reference to all preceding applications. The earliest effective filing date of application E with respect to any common subject matter in the prior applications is:

- (A) October 21, 1993.
- (B) December 20, 1996.
- (C) October 29, 1993.
- (D) September 9, 1988.
- (E) July 22, 1999.

The model answer is choice is (E). The earliest effective filing date of application E with respect to any common subject matter in the prior applications is July 22, 1999.

Petitioner selected answer (B). Petitioner argues that the question did not state that the Office actions in the applications C and D set forth shorten statutory periods for reply. Petitioner concludes that the application E is copending with applications C and D, thus the earliest effective filing date of application E would be October 21, 1993. However, petitioner's argument does not support her allegation that choice B is correct because October 21, 1993 is stated in choice A, but not in choice B.

Petitioner's arguments have been fully considered but they are not persuasive. According to the instructions, "[t]he most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP). . . ." Under the authority given him by 35 U.S.C. §133, the Commissioner has directed the examiner to set a shortened period for reply to every action. MPEP 710.02(b). A three-month shortened statutory period is to set for reply to all Office actions on the merits. MPEP 710.02(b). In accordance with the PTO practice and procedure, a three-month shortened statutory period would have been set in each of the Office actions in the applications C and D. Therefore, applications C and D would have been abandoned after midnight of July 21, 1999. There is no copendency between application E and any prior applications. Hence, choice E is the best answer.

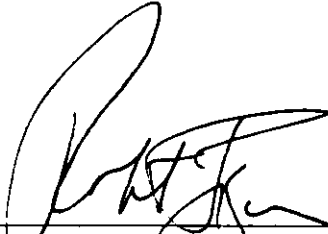
No error in grading has been shown as to morning questions 16 and 39 and afternoon questions 16 and 49. Petitioner's request for credit on these questions is denied.

ORDER

For the reasons given above, no points have been added to petitioner's score on the Examination. Therefore, petitioner's score is 69. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.



Robert J. Spar
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy